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EXAMINER

LIVERSEDGE, JENNIFER L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/764,068	Applicant(s) EDER, JEFF SCOTT	
	Examiner JENNIFER LIVERSEDGE	Art Unit 3684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-65,67-69 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-65,67-69 and 72-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for continued examination of application 09/764,068 filed July 11, 2010 following an Appeal Brief and an Examiner's Answer.

The amendment contains previously presented claims: 45 and 57.

The amendment contains amended claims: 36-44, 46-56, 58-65, 67-69, 72-75.

Claims 1-35, 66 and 70-71 have been canceled.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 11, 2010 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the initial disclosure in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites new matter with respect to elements of value “physically exist”. The term is not found within the initial disclosure and therefore is improper to use within the claim limitations. Each claim limitation needs to be supported by a particular section in the initial disclosure in order to comply with the written description requirement.

Claims 64-65 and 67-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the initial disclosure in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites new matter with respect to “a physical object or substance”. The term is not found within the initial disclosure and therefore is improper to use within the claim limitations. Each claim limitation needs to be supported by a particular section in the initial disclosure in order to comply with the written description requirement.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 36, 46, 55 and 72 recite in part "an enterprise/organization that physically exists". Examiner recommends removal of the term "that physically exists" as it is unclear how an enterprise physically exists. While an enterprise may operate in a physically structure or building, and contain physically components therein, an enterprise is generally considered to be an organization comprised of both physical and non-physical components.

Claims 36, 47, 55 and 75 recite in part that "elements of value physically exist and are selected from the group consisting of alliances, brands, channels, customers, employees, intellectual property, partnerships, processes, vendors and combinations thereof. However, it is unclear how these elements all physically exist. For example, while the elements of customers and employees physically exist, other elements such as alliances and partnerships do not physically exist. With respect to a brand, for example, the product with a brand name physically exists, but does the brand actually physically exist.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 46, 48 and 53-54 are rejected under 35 U.S.C. 102(b) as being anticipated by "How to sort out the premium drivers of post-deal value" by Daniel W. Bielinski (further referred to as Bielinski).

Regarding claim 46, Bielinski discloses a non-transitory program storage device readable by a computer, tangibly embodying a program of instructions executable by a computer to perform steps (pages 1-7), comprising:

Preparing data representative of an enterprise that physically exists for use in processing, transforming at least a portion of the data into a causal model of each of one or more categories of an organization value (pages 1-7) that identify and output a tangible contribution of each of one or more elements of value (page 1, section 1; page 2, sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6) to a value of a current operation and a real option category of value (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5), and

reporting the value contribution of the elements of value using an electronic display or a paper document (page 1, section 1; page 3, section 10; page 4, sections 4 and 6-7).

Regarding claim 48, Bielinski discloses wherein the tangible value contribution for each of one or more elements of value to each of the one or more categories of

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value further comprises a direct element contribution to a category of value net of any element of value impacts on other elements of value (page 1, section 2; page 2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page 6, sections 5-6).

Regarding claim 53, Bielinski discloses wherein the calculated value for each element of value further comprises a value for a point in time within a sequential series of points in time (page 1, section 1; page 2, section 1; page 6, section 5).

Regarding claim 54, Bielinski discloses wherein the tangible value contribution of each of the one or more elements of value comprises a net relative contribution for each element of value to each category of value and the other elements of value (page 1, section 2; page 2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page 6, sections 5-6).

Claims 36-39, 41-43, 45, 55 and 58-63 is rejected under 35 U.S.C. 103(a) as being unpatentable over “How to sort out the premium drivers of post-deal value” by Daniel W. Bielinski (further referred to as Bielinski), and further in view of “The 1986-88 stock market: investor sentiment or fundamentals?” by Baur, Quintero and Stevens (further referred to as Baur).

Regarding claim 36, Bielinski discloses an enterprise method (pages 1-7), comprising:

Using a computer (pages 1-7) to complete the steps of:

Preparing data representative of an enterprise that physically exists for use in processing, and transforming at least a portion of the data into a model of an enterprise market value by a category of value by completing a plurality of multivariate analyses that utilizes said data (pages 1-7),

Where the categories of value are selected from the group consisting of current operation, real option and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Where the model of enterprise market value identifies and outputs a tangible contribution of each of one or more elements of value to each category of value (page 1, section 1; page 2, sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6).

Bielinski does not disclose where the elements of value [physically exist and] are selected from the group consisting of alliances, brands, channels, customers, employees, intellectual property, partnerships, processes, vendors and combinations thereof. However, Bielinski does disclose where the elements of value [physically exist and] are selected from alliances, employees, partnerships, processes and vendors (page 3, sections 1-5; page 4, sections 4-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a

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group known in the art. Therefore it would be obvious to provide further elements of value as are known to be a part of a group in the art.

Bielinski does not disclose where a category of value is market sentiment. However, Baur discloses where a category of value is market sentiment (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and pricing/value factor as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.

Regarding claim 37, Bielinski does not disclose completing activities from the group consisting of the full list of activities as cited. However, Bielinski discloses completing activities from the group such as: identifying a set of changes that will optimize one or more aspects of enterprise financial performance and creating a management report valuing a real option, and combinations thereof (pages 1-5). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further completion of activities as are known to be a part of a group in the art.

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Regarding claim 38, Bielinski discloses identifying one or more changes that will optimize one or more aspects of financial performance (pages 1-7). Bielinski does not disclose where the aspects of enterprise financial performance are selected from the group consisting of revenue, expense, capital change, cash flow, real option value, future market value, market sentiment value, market value and combinations thereof. However, Bielinski discloses where aspects of financial performance are selected from the group such as: revenue, expense, cash flow, real option value, future market value, market value and combinations thereof (pages 1-7). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further aspects of financial performance as are known to be a part of a group in the art.

Regarding claim 39, Bielinski does not disclose where a series of multivariate analyses are selected from the group consisting of the full list as cited in the claim. However, Bielinski discloses where a series of multivariate analyses are selected from the group such as identifying one or more previously unknown relationships between one or more value drivers, identifying one or more previously unknown relationships between one or more elements of value, quantifying one or more inter-relationships between value drivers, quantifying one or more impacts between elements of value, determining a net impact for each category of value, calculating one or more real option values, and combinations thereof (pages 1-7). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a

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group known in the art. Therefore it would be obvious to provide further multivariate analyses as are known to be a part of a group in the art.

Regarding claim 41, Bielinski does not disclose wherein data representative of an enterprise are obtained from systems selected from the group consisting of the full list as cited in the claim. However, Bielinski discloses wherein data representative of an enterprise are obtained from systems selected from the group such as advanced financial systems, basic financial systems, process management systems, supply chain management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, inventory systems, and combinations thereof (pages 1-7). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further enterprise transaction data as are known to be a part of a group in the art.

Regarding claim 42, Bielinski discloses using one or more composite applications to complete the processing (page 1, section 1; page 2, section 1; page 3, sections 8-9; page 7, section 6).

Regarding claim 43, Bielinski does not disclose a combination of models selected from the group consisting of up to three predictive component value models, a real

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option discount rate model, a real option valuation model, a market sentiment model by element of value and combinations thereof. Bielinski discloses a combination of models selected from the group consisting of up to three predictive component value models, a real option valuation model, and combinations thereof (pages 1-7). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further models as are known to be a part of a group in the art.

Regarding claim 45, Bielinski discloses identifying one or more changes that will optimize a future market value portion of said enterprise market value (pages 1-7).

Regarding claim 55, Bielinski discloses a future market value method (pages 1-7), comprising:

Using a computer (pages 1-7) to complete the steps of:

Preparing data representative of an organization [that physically exists] for use in processing, transforming at least a portion of the data into a causal model of each of one or more categories of an organization value (pages 1-7), that calculate and output a tangible value contribution of each of one or more elements of value to a future market value and each of the categories of organization value (page 1, section 1; page 2, sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6)

Where the categories of value comprise a current operation and a real option category and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Bielinski does not disclose where the elements of value are selected from the group consisting of alliances, brands, channels, customers, employees, intellectual property, partnerships, processes, vendors and combinations thereof. However, Bielinski does disclose where the elements of value are selected from alliances, employees, partnerships, processes, vendors and vendor relationships (page 3, sections 1-5; page 4, sections 4-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further elements of value as are known to be a part of a group in the art.

Bielinski does not disclose where a category of value is market sentiment. However, Baur discloses where a category of value is market sentiment (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and pricing/value factor as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.

Regarding claim 58, Bielinski discloses wherein the contribution for each of the one or more elements of value to each of the one or more categories of value further comprises a direct element contribution to the category of value net of any element impacts on other elements of value that contribute to said category of value (page 1, section 2; page 2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page 6, sections 5-6).

Regarding claim 59, Bielinski does not disclose models selected from the group consisting of predictive component of value models, predictive market value models, relative element strength models, real option discount rate models, real option valuation models, market sentiment models and combinations thereof. Bielinski discloses models selected from the group consisting of predictive component of value models, predictive market value models, relative element strength models, real option valuation models, and combinations thereof (pages 1-7). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further models as are known to be a part of a group in the art.

Regarding claim 60, Bielinski discloses wherein the contribution for each of the one or more elements of value further comprises a direct contribution to a value of all of the categories of value net of any impact on the other elements of value (page 1,

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section 2; page 2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page 6, sections 5-6).

Regarding claim 61, Bielinski discloses wherein one or more categories of value are selected from the group consisting of current operation, real option and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5). Bielinski does not disclose where a category of value is market sentiment. However, Baur discloses where a category of value is market sentiment (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.

Regarding claim 62, Bielinski discloses wherein the future market value portion of organization market value comprises a summation of values selected from current operation value, real option value and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5). Bielinski does not disclose market sentiment value. However, Baur discloses market sentiment in valuation (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3).

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It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.

Regarding claim 63, Bielinski does not disclose wherein one or more value driver changes that will optimize the future market value are identified by algorithms selected from the group consisting of monte carlo algorithms, genetic algorithms, multi criteria optimization algorithms and combinations thereof. However, Bielinski discloses wherein one or more value driver changes that will optimize the future market value are identified by multi criteria optimization algorithms (page 2, section 1; page 3, sections 7-9; page 4, section 7; page 5, section 1; page 6, sections 5-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further algorithms as are known to be a part of a group in the art.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski.

Regarding claim 47, Bielinski does not disclose wherein the elements of value [physically exist and] are selected from the group consisting of alliances, brands,

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channels, customers, employees, intellectual property, partnerships, processes, production equipment, vendors and combinations thereof. However, Bielinski does disclose where the elements of value are selected from alliances, employees, partnerships, processes, production equipment, vendors (page 3, sections 1-5; page 4, sections 4-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further elements of value as are known to be a part of a group in the art.

Claims 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over “How to sort out the premium drivers of post-deal value” by Daniel W. Bielinski (further referred to as Bielinski), in view of “The 1986-88 stock market: investor sentiment or fundamentals?” by Baur, Quintero and Stevens (further referred to as Baur), and further in view of US Patent 4,989,141 to Lyons et al. (further referred to as Lyons).

Regarding claim 72, Bielinski discloses an organization system comprising a computer with a processor having circuitry to execute instructions, a storage device available to said processor with sequences of instructions stored therein, which when executed cause the processor to complete a series of steps (pages 1-7), comprising:

Preparing a plurality of data representative of an organization [that physically exists] for use in processing, transforming at least a portion of the data into a model of each of one or more categories of an organization value (pages 1-7), that identify and

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output a tangible contribution of each of one or more elements of value to the categories of organization value by completing a series of analyses (page 1, section 1; page 2, sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6)

Where the categories of value further comprise a current operation category of value and a real option category and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Using the tangible contribution for each element of value to identify a market value for each element of value (page 1, section 1; page 2, sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6), and

Reporting the value of each element of value (page 1, section 1; page 3, section 10; page 4, sections 4 and 6-7).

Bielinski does not disclose where a category of value is market sentiment. However, Baur discloses where a category of value is market sentiment (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and to calculate stock price using sentiment as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.

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Neither Bielinski nor Baur disclose reporting in a balance sheet format and where the reported value is a value for a specific point in time within a sequential series of points in time. However, Lyons discloses reporting in a balance sheet format (column 2, lines 16-34; column 3, lines 1-10; column 10, lines 1-9; column 16, lines 61-68; column 24, line 50 – column 25, line 12 where it is disclosed that users input data from various reports such as balance sheets and income statements, the data can be manipulated and analyzed across departments in an organization, for example, and then a report can be generated representing data as requested by a user and wherein it would be obvious that if data is submitted in the form of a balance sheet or income statement, that data could then be output in the same format) and where the reported value is a value for a specific point in time within a sequential series of points in time (column 2, lines 61-66; column 8, lines 56-61). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the data analysis of key drivers of market value as disclosed by Bielinski and Baur to adapt the use of providing reports in balance sheet format and providing values for a specific point in time across a sequential period of time as disclosed by Lyons. The motivation would be that a balance statement provides key data in understanding market value of an enterprise, and further value is analyzed and understood at certain points in time relative to a continuum of time.

Regarding claim 73, neither Bielinski nor Baur disclose including a value for one or more financial assets in a report with a balance sheet format. However, Lyons discloses including a value for a plurality of financial assets in a report with a balance

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sheet format (column 2, lines 16-34; column 3, lines 1-10; column 10, lines 1-9; column 16, lines 61-68; column 24, line 50 – column 25, line 12) where it is disclosed that users input data from various reports such as balance sheets and income statements, the data can be manipulated and analyzed across departments in an organization, for example, and then a report can be generated representing data as requested by a user and wherein it would be obvious that if data is submitted in the form of a balance sheet or income statement, that data could then be output in the same format. Given the combination of Bielinski, Baur and Lyons as cited in claim 72 with regards to presenting data in a balance sheet format, it is further obvious to report multiple values in a balance sheet format as balance sheets contain various types of data.

Regarding claim 74, neither Bielinski nor Baur specifically disclose tracking a change in the market value of each of the one or more elements of value over time, and including the calculated changes in the market value of each element of value in an income statement or a cash flow statement. However, Lyons discloses tracking a change in the market value of each of one or more elements of value over time (column 2, lines 58-66; column 8, lines 56-61), and including the calculated changes in market value of each element of value in an income statement or a cash flow statement (column 2, lines 16-34; column 3, lines 1-10; column 10, lines 1-9; column 16, lines 61-68; column 24, line 50 – column 25, line 12) where it is disclosed that users input data from various reports such as balance sheets and income statements, the data can be manipulated and analyzed across departments in an organization, for example, and

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then a report can be generated representing data as requested by a user and wherein it would be obvious that if data is submitted in the form of a balance sheet or income statement, that data could then be output in the same format. Given the combination of Bielinski, Baur and Lyons as cited in claim 72 with regards to presenting data in a balance sheet format, it is further obvious to report values over a period of time in traditional financial forms such as an income statement or cash flow statement format.

Regarding claim 75, Bielinski does not disclose where the elements of value are customers and elements of value that [physically exist and are] selected from the group consisting of alliances, brands, channels, employees, intellectual property, partnerships, processes, vendors and vendor relationships and combinations thereof. However, Bielinski does disclose where the elements of value are selected from alliances, employees, partnerships, processes, vendors and vendor relationships (page 3, sections 1-5; page 4, sections 4-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further elements of value as are known to be a part of a group in the art.

Claim 64-65 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 7,249,328 B1 to Davis (further referred to as Davis), and further in view of "How to sort out the premium drivers of post-deal value" by Daniel W. Bielinski (further referred to as Bielinski).

Regarding claim 64, Davis discloses a composite application method for data processing, comprising:

Using two or more independent components of application software to instruct a processor in a computer to produce one or more useful results (column 8, lines 23-51; column 9, lines 1-11; column 12, lines 11-56; column 36, lines 59-67; column 37, lines 5-8; column 38, lines 48-56);

by transforming a plurality of data representative of a physical object or substance with a utility in managing or monitoring a real world activity of said object or substance (column 8, lines 23-51; column 9, lines 1-11; column 12, lines 26-56; column 37, lines 5-8; column 38, lines 48-56).

where data has been aggregated from two or more systems (column 8, lines 29-34; column 10, lines 25-26; column 11, lines 24-27; column 12, lines 26-29 and lines 53-56; column 28, lines 31-34; column 38, lines 50-53)

in accordance with a common model or schema defined by an xml metadata standard (column 8, lines 40-46 and lines 52-57; column 10, lines 31-33 and lines 52-55; column 11, lines 24-66; column 12, lines 45-56; column 13, lines 34-37; column 15, lines 60-67; column 18, lines 48-54; column 26, lines 65-67; column 27, lines 1-5; column 28, lines 31-34; column 30, lines 42-50; column 30, lines 51-60; column 33, lines 15-47; column 37, lines 5-8; column 38, lines 48-56).

Davis does not disclose where data is transformed into a predictive model. However, Bielinski discloses where data is transformed into a predictive model (page 1,

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section 1; page 2, section 1; page 4, section 2; page 6, section 2). It would be obvious to one of ordinary skill in the art to modify the use of graphing and charting of data received from multiple sources for the purpose of tracking how organizations are performing, for example, as disclosed by Davis to adapt the use of predictive models as disclosed by Bielinski. The motivation would be that as historic and current data is obtained and useful for understanding what has occurred in the far or recent past, businesses are always looking forward and attempting to quantify and understand how the future value of a company can be maximized, as disclosed by Bielinski, where this analysis includes both past-, present- and future-looking data.

Regarding claim 65, Davis discloses wherein the independent components of application software can be flexibly combined as required to support the development of one or more useful results (column 8, lines 23-51; column 9, lines 1-11; column 12, lines 11-56; column 36, lines 59-67; column 37, lines 5-8; column 38, lines 48-56).

Regarding claim 67, Davis does not disclose wherein the independent components of application software complete processing selected from the group consisting of the full list as stated in the claim limitation. However, Davis discloses where the independent components of application software complete processing selected from the group such as: analysis, attribute derivation, classification, clustering, data acquisition, data conversion, data storage, data transformation, keyword match identification, and combination thereof (column 4, lines 10-45; column 8, lines 24-46;

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column 8, line 65 – column 9, line 5; column 9, lines 59-67; column 10, lines 19-53; column 11, lines 24-64; column 12, lines 15-56; column 13, lines 20-48; column 15, lines 60-67; column 16, lines 11-15; column 17, lines 7-12 and lines 38-67; column 18, lines 1-67; column 20, lines 32-38; column 21, lines 26-59; column 23, lines 64-67; column 26, lines 47-67; column 27, lines 1-21; column 28, lines 31-39; column 30, lines 51-58; column 31, lines 33-50; column 33, lines 28-47; column 36, lines 59-67; column 37, lines 5-8; column 38, lines 48-65; column 45, lines 1-14; column 49, lines 19-48; column 50, lines 38-49). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further processes as are known to be a part of a group in the art.

Regarding claim 68, Davis does not disclose wherein the useful results are selected from the group consisting of the full list as stated in the claim limitation. However, Davis discloses where the useful results are selected from the group such as: enterprise financial performance analysis, management reporting, share price valuation, sub-element clustering and combinations thereof (column 8, lines 36-51; column 9, lines 59-67; column 10, lines 31-53; column 11, lines 52-62; column 12, lines 26-56; column 45, lines 1-14 and lines 40-50; column 49, lines 20-42). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further useful results as are known to be a part of a group in the art.

Regarding claim 69, Davis does not disclose wherein the two or more systems are selected from the group consisting of the full list as stated in the claim limitation. However, Davis discloses where the enterprise management systems are selected from the group such as: accounts receivable systems, accounts payable systems, advanced financial systems, basic financial systems, process management systems, operation management systems, sales management systems, capital asset systems, inventory systems, the Internet, external databases and combinations thereof (column 8, lines 24-51; column 9, lines 59-67; column 10, lines 31-53; column 11, lines 52-62; column 12, lines 26-56; column 45, lines 1-14 and lines 40-50; column 49, lines 20-42). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further systems as are known to be a part of a group in the art.

Claims 44 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski and Baur as applied to claims 36 and 55 above, and further in view of Davis.

Regarding claim 44, neither Bielinski nor Baur disclose where preparing the data for use in processing further comprises integrating said data in accordance with a common schema where the common schema is defined by a COBRA metadata or an xml metadata standard. However, Davis discloses where preparing transaction data for

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use in processing further comprises integrating said data in accordance with a common schema where the common schema is defined by a COBRA metadata or an xml metadata standard (column 8, lines 40-46 and lines 52-57; column 10, lines 31-33 and lines 52-55; column 11, lines 24-66; column 12, lines 45-56; column 13, lines 34-37; column 15, lines 60-67; column 18, lines 48-54; column 26, lines 65-67; column 27, lines 1-5; column 28, lines 31-34; column 30, lines 42-50; column 30, lines 51-60; column 33, lines 15-47; column 37, lines 5-8; column 38, lines 48-56) to support organization processing (column 8, lines 29-34 and lines 40-51; column 9, lines 1-6; column 10, lines 19-30; column 12, lines 15-17; column 13, lines 19-23; column 25, lines 53-60; column 26, lines 47-67; column 28, lines 31-40; column 36, lines 59-67; column 37, lines 5-12; column 38, lines 48-65). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the data analysis for value drivers as disclosed by Bielinski and Baur to adapt the use of integrating data using xml metadata as disclosed by Davis. The motivation would be that to understand the overall value of an enterprise, it would be advantageous to gather data from various groups and departments and providing a common schema for doing so creates a more efficient means of sharing data, as disclosed by Davis.

Regarding claim 57, neither Bielinski nor Baur disclose the use of a flexible system architecture where said architecture further comprises event data that has been integrated in accordance with a common xml schema and independent components of application software that can be combined to process said data as required to produce

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useful results. However, Davis discloses the use of a flexible system architecture where said architecture further comprises event data that has been integrated in accordance with a common xml schema and independent components of application software that can be combined to process said data as required to produce useful results (column 8, lines 40-46 and lines 52-57; column 10, lines 31-33 and lines 52-55; column 11, lines 24-66; column 12, lines 45-56; column 13, lines 34-37; column 15, lines 60-67; column 18, lines 48-54; column 26, lines 65-67; column 27, lines 1-5; column 28, lines 31-34; column 30, lines 42-50; column 30, lines 51-60; column 33, lines 15-47; column 37, lines 5-8; column 38, lines 48-56) It would be obvious to one of ordinary skill in the art at the time of the invention to modify the data analysis for value drivers as disclosed by Bielinski and Baur to adapt the use of integrating data using xml metadata as disclosed by Davis. The motivation would be that to understand the overall value of an enterprise, it would be advantageous to gather data from various groups and departments and providing a common schema for doing so creates a more efficient means of sharing data, as disclosed by Davis.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski and Baur as applied to claim 39 above, and further in view of US Patent 6,192,354 B1 to Bigus et al. (further referred to as Bigus).

Regarding claim 40, neither Bielinski nor Baur disclose wherein the predictive model algorithm is selected from the group consisting of neural network; classification

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and regression tree; generalized autoregressive conditional heteroskedasticity, regression; generalized additive; redundant regression network; rough-set analysis; Bayesian; multivariate adaptive regression spline and support vector method. However, Bigus discloses wherein the selected predictive model algorithm is Bayesian (column 12, lines 40-65; column 12, lines 28-33). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the use of optimization using predictive models as disclosed by Bielinski and Baur to adapt the optimization of tasks using a Bayesian predictive algorithm as disclosed by Bigus. The motivation would be to use a well known algorithm which enables machine learning in order to improve the predictive results.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski as applied to claim 46 above, and further in view of US Patent 5,245,696 to Stork et al. (further referred to as Stork).

Regarding claim 50, Bielinski does not disclose wherein the element of value contributions are identified by learning from the data. However, Stork discloses learning from data. It would be obvious to one of ordinary skill in the art at the time of the invention to modify the predictive modeling for optimization as disclosed by the Bielinski to adapt the use of learning from the data, such as through genetic algorithms, as disclosed by Stork. The motivation would be to provide a means by which the modeling would continue to make better optimizations based on data and feedback.

Claims 49 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski as applied to claim 46 above, and further in view of "Get Real: using real options in security analysis" by Michael J. Mauboussin of Credit Suisse First Boston (further referred to as Mauboussin).

Regarding claims 49 and 51, Bielinski discloses identifying one or more elements of value that make a casual contribution to an organization market value (pages 1-7).

Bielinski does not disclose computing a difference between a real option value calculated using the company cost of capital as the discount rate and a value calculated using a real option discount rate comprised of a base discount rate plus a risk factor for each element of value that makes a causal contribution to organization market value; and assigning the value difference to the different elements of value based on their relative contribution to a calculated difference in the two discount rates. However, Mauboussin discloses calculating the difference between real option value using current equity value and discounted cash flow analysis (page 3, section 8; page 15, sections 1-2 and 6) in order to capture the value of real options (page 4, section 1; page 13, section 5) where an evaluation of risk and the difference in value when including real options is allocated to an investment potential (page 5, sections 4-6; page 15, sections 2 and 6) such that an understanding between disparities between discounted cash flows and stock prices can be understood (page 8, section 3; page 13). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation of

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real options as disclosed by Bielsinski to adapt the computational techniques as disclosed by Mauboussin. The motivation would be to use mathematical techniques which have been determined to best capture the value of real options as an enterprise considers their overall value and conducts stock price analysis.

Regarding claim 52, Bielsinski discloses identifying one or more value drivers for each element of value (pages 1-7), developing one or more element impact summaries from said value drivers for an organization market value and each of one or more components of value (page 1, sections 1-2; page 2, sections 1 and 7; page 3, sections 7-9; page 4, sections 1-4 and 7), identifying a best fit combination of the element impact summaries and a predictive model algorithm for modeling the organization market value and each of the components of value (page 2, section 1; page 3, sections 7-9; page 4, sections 4 and 7; page 5, section 1; page 6, section 5-6), determining a relative strength for each of the elements of value change vis a vis competitors (page 2, section 1; page 3, sections 7-9; page 4, sections 4 and 6-7), calculating a real option value, identifying a net element contribution to enterprise market value by category of value by combining the results from the processing of steps above (page 3, sections 7-9; page 4, sections 6-7; page 5, section 1; page 6, sections 3-6). Bielsinski does not disclose calculating a real option discount rate and calculating the real option value using the discount rate. However, Mauboussin discloses calculating a real option discount rate and calculating the real option value using the discount rate (page 4, section 1; page 5, sections 4-6; page 8, section 3; page 15, sections 1-2 and 6). It would be obvious to one of ordinary

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skill in the art at the time of the invention to modify the valuation of real options as disclosed by Bielinski to adapt the computational techniques as disclosed by Mauboussin. The motivation would be to use mathematical techniques which have been determined to best capture the value of real options as an enterprise considers their overall value and conducts stock price analysis.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski and Baur as applied to claim 55 above, and further in view of "Get Real: using real options in security analysis" by Michael J. Mauboussin of Credit Suisse First Boston (further referred to as Mauboussin).

Regarding claim 56, Bielinski discloses identifying one or more elements of value that make a casual contribution to an organization market value (pages 1-7).

Neither Bielinski nor Baur disclose wherein the discount rate for a real option category of value valuation comprises a base discount rate plus a risk factor for each element of value that is causal to organization market value. However, Mauboussin discloses calculating the difference between real option value using current equity value and discounted cash flow analysis (page 3, section 8; page 15, sections 1-2 and 6) in order to capture the value of real options (page 4, section 1; page 13, section 5) where an evaluation of risk and the difference in value when including real options is allocated to an investment potential (page 5, sections 4-6; page 15, sections 2 and 6) such that an understanding between disparities between discounted cash flows and stock prices

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can be understood (page 8, section 3; page 13). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation of real options as disclosed by Bielinski and Baur to adapt the computational techniques as disclosed by Mauboussin. The motivation would be to use mathematical techniques which have been determined to best capture the value of real options as an enterprise considers their overall value and conducts stock price analysis.

Response to Arguments

Applicant speaks to a number of supposed errors in the rejection of the claims in the present application. Examiner respectfully disagrees with the arguments and finds that the prior art references as applied in the Final Office Action and the Examiner's Answer are proper, pertinent, and relevant in disclosing the claims as submitted.

Applicant argues that the prior art references teach away from the claimed invention. Examiner respectfully disagrees and does not find any instances where the prior art cited teaches away from the claims as presented in the present application. None of the prior art references relied upon in anyway discredit or criticize the claims as presented in this application. It is stated that "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Applicant has argued that the cited references fail to teach or suggest one or more limitations of the claims. However, examiner contends that each limitation has been addressed by a proper reference and through proper combinations. Every limitation has been addressed in the Office Action, with each claim limitation mapped, and every word of the claim taken into consideration. Due to the lengthy rejection presented above, the claims and their respective mapping will not be reiterated here. However, examiner contends that a thorough review and mapping of the claims has been conducted in accordance with procedures of claim interpretation and analysis.

Applicant argues that the combination of references would not provide for functionality as described. However, examiner notes that the arguments presented are outside the scope of the claims and that as presented, the references are proper combinations yielding predictable results. The elements for which the references were relied upon, based on the analogous art as described above, would properly be combined with functionality as disclosed. For example, Bielinski discloses the use of modeling for representing organization data such that analysis can be performed to understand and study element contributions, values and effects. While Bielinski teaches a number of values used in modeling, Bielinski does not teach market sentiment. Baur teaches market sentiment in analysis. Incorporating multiple values into a model is old and well known, even where Bielinski discloses the inclusion of multiple variables. Examiner therefore contends that functionality would remain by using the models across the systems. Likewise, examiner asserts that combinations with the other references relied upon in the Office Action would provide for functionality

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when combined. A full analysis of why the references would be combined and the combination obvious is provided above, with motivations for combination which would provide for predictable results.

Applicant argues that Examiner has failed to explain the rationale for combining the teachings of the cited documents. However, in each instance of combination, the reason for the combination has been provided in terms of which limitations are taught by which reference, and a motivation for the combination has been provided. Examiner believes that proper combinations have been made and proper motivations and rationales set forth within the claim rejections. The courts have found that "A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In *re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *Lee*, 277 F.3d at 1343-46; *Rouffett*, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See *id.* at 1344-45." In *re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). XXXXX "It is, of course, not necessary

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that either [prior art references] actually suggest, expressly or in so many words, the changes or possible improvements appellant has made." In re Sheckler, 168 USPQ 716, 717 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that "[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references...The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (emphasis added) In re Kahn, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that "articulated reasoning" to support the legal conclusion of obviousness has been made.

With regards to Applicants claim that the rejections fail under APA standards, Examiner believes that the claims have been properly rejected. Examiner believes that the rejections as set forth in the Office Actions have addressed each claim limitation using prior art which addresses the claim limitations and that where any combinations of prior art were used to reject claims that proper evidence and motivation for such a combination has been provided. Therefore the Examiner asserts that both standards of the APA have been followed and that the Office Action is proper with respect to the evidence provided in rejecting the claims.

Likewise, Appellant has argued that examiner has failed to explain what would motivate someone to make the combinations as set forth above. However, examiner contends, again, the proper combinations and motivational statements have been provided. Evidence has been provided for the claim rejections, as provided above in the detailed mapping of each claim limitation, as well as with the motivation statements. Examiner contends that proper APA standards have been followed in all regards.

With regards to prior art arguments, examiner contends that the claims have been properly analyzed and rejected based on the prior art of record. Examiner contends that the level of detail in the claims has been properly considered, that the prior art has been properly mapped to the claim limitations, following all appropriate standards and procedures.

With regards to the arguments set forth regarding 112 first paragraph, examiner contends that the 112 first paragraph rejections are proper. Examiner has noted the phrases "an integrated database", "output said database" and "a physical object or substance" as the phrases which are unsupported in the initial disclosure. While it is not required that the exact and specific words be used in the initial disclosure as support for the language amended into a claim, the language is required to be supported by the initial disclosure. Examiner contends that the phrases above were amended into the claims, but that there is not support for the phrases. Support is found in neither the use of specific and exact words, nor within provided or determined context from which the material can be obtained. In order to amend claims, the amendments must be supported by the initial disclosure be it in the drawings, specification or claims.

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However, upon presenting the amendments being discussed, there was no indication as to where support for these elements could be found, and examiner was unable to find support for these elements and therefore the 112 rejections were made. Examiner contends that the 112 rejections for new matter are proper and maintains the rejections.

The 112 second paragraph rejections are also argued. The 112 rejections as set forth above detail the lack of clarity found in the language and the rejections stand.

Examiner contends that the meets and bounds of the claims are unclear based on the reasoning and rationale as detailed above and that the claims are unclear as presented.

In each instance, the examiner stated what would be assumed for purposes of examination. In each case, the Appeal Brief notes that the examiner was incorrect.

Examiner finds that supports the examiner's position that the claims are unclear as a reasonable interpretation of the claim limitation meets and bounds could not be inferred from the claim limitations as presented. Examiner finds that the 112 second paragraph rejections are proper and appropriate.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Primary Examiner, Art Unit 3684